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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,347

03/26/2004

Ray R. Eshraghi

4172-120

1569

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05/01/2006

INTELLECTUAL PROPERTY / TECHNOLOGY LAW

PO BOX 14329

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/811,347	ESHRAGHI ET AL.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68,71 and 76-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-68,71 and 76-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-68, 71 and 76-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the independent claims (1, 23, 44, 56, 66, 71 and 76) to recite that the layers that are extrusion coated or formed by extrusion over the solid core form a "substantially circumferentially uniform" layer. However, an electronic check of the PG Pub 2004/0197557 which corresponds to the instant application indicates that the term "uniform" does not appear in the document. Also, the only time "substantially" occurs is in reference to the resultant hollow fiber having a wall that is "substantially free of deformation defects". This, of course, does not necessarily mean that the layers, one of which will become the hollow fiber, are substantially circumferentially uniform. All it means is that there are no deformation defects. Hence, it is submitted that the amendment constitutes new matter unless applicant can show exactly where support exists for the added language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-68, 71 and 76-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al in view of Ishikawa et al essentially for reasons of record.

3. Applicant's arguments filed February 16, 2006 have been fully considered but they are not persuasive. Applicant has amended the claims in a manner which introduces new matter and this needs to be addressed. Also, while applicant submits that the claims are not obvious in view of the references, such is not persuasive of error in the rejection. Note column 3, lines 6-10 of Hoffman et al, which clearly discloses that the surface coating is not materials limited due to the "so many different processes" available to perform the coating. The processes disclosed thereafter admittedly do not include extrusion. However, the primary reference also clearly teaches that the processes noted "**include but are not limited to**" (see col. 3, line 8) the disclosed processes. Extrusion is clearly a process by which a hollow fiber would be formed, and such is done in Ishikawa et al by extruding both the layer that is to become the hollow fiber and the core it is formed around. Looking at the combined teachings of the references, it is rather clear that one of ordinary skill in the art would have found the instant claims obvious thereover. Ishikawa et al does not have to teach extrusion over a solid core, since the primary reference teaches the solid core. Rather, Ishikawa et al is being applied to teach what the primary reference lacks—namely, the making of a fiber by extrusion coating of layer(s) and removal of the core or sheath to arrive at the desired fiber. While applicant argues the aspect of circumferentially uniform, it is respectfully submitted that such would not obviate the rejection. First of all, it would

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appear that such a recitation constitutes new matter. Even if such is determined not to be new matter, Ishikawa et al uses a particular process by which a desired non-uniformity is achieved. One of ordinary skill, not needing such irregularity, would realize from the primary reference that extrusion would have been used to make uniform circumferential layers. Again, the primary reference merely lists representative processes by which the layers would be coated on the solid core. Clearly, Ishikawa et al shows extrusion as a viable process to make fibers from which a core or sheath portion is selectively removed to make the desired fiber. One of ordinary skill in this art would have had no problem in combining the teachings as applied to employ the extrusion shown in Ishikawa et al as a coating process in Hoffman et al.

4.THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1211. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
April 27, 2006


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

4/27/06